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8 **UNITED STATES DISTRICT COURT**
9 **SOUTHERN DISTRICT OF CALIFORNIA**
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11 BMW OF NORTH AMERICA, LLC, et al.,
12 Plaintiffs,
13 vs.
14 EUROTECH WHEELS, LLC, et al.,
15 Defendants.
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CASE NO. 08 CV 0171 JM (WMc)

**ORDER GRANTING JOINT
MOTION FOR ENTRY OF AND
ENTERING CONSENT
PERMANENT INJUNCTION AS
TO DEFENDANTS RYAN
MOALEMI AND JOSHUA
MOALEMI**

17 The parties filed a joint motion for entry of consent permanent injunction as to Defendants
18 Ryan Moalemi and Joshua Moalemi. (Doc. no. 28.) Pursuant to the joint motion and for good
19 cause shown, the court hereby **GRANTS** the joint motion and issues the following **ORDER**:

20 This matter having been opened to the Court upon the Complaint of Plaintiffs BMW of
21 North America, LLC and Bayerische Motoren Werke AG (collectively, "BMW") against
22 Defendants Eurotech Wheels, LLC, Eurotech Rims, LLC, Ryan Moalemi and Joshua Moalemi
23 (collectively, "Eurotech") alleging trademark infringement under the Federal Trademark Act (the
24 "Lanham Act"), 15 U.S.C. § 1114 and the common law of California; unfair competition and false
25 designation of origin under 15 U.S.C. § 1125(a) and under the common law of California;
26 trademark counterfeiting under 15 U.S.C. § 1114(1); unfair competition under Cal. Bus. & Profs.
27 Code § 17200 *et seq.*; and, as to the corporate defendants, design patent infringement under 35
28 U.S.C. §271;

1 Ryan and Joshua Moalemi,

2 a) having allegedly advertised and sold wheels in violation of BMW's
3 trademark and design patent rights;

4 b) having represented and warranted that Eurotech Wheels, LLC's only
5 warehouses for wheels that fit BMWs are three located at 6350 Nancy Ridge Road, Suite #104,
6 San Diego, CA 92121, and that it has no parent, subsidiary, or affiliated businesses of any kind
7 that are involved in wheels for BMWs;

8 c) having represented and warranted that each of them has no challenged
9 wheel designs in his personal possession, custody or control; that the only other business(es)
10 involving wheels for BMW in which either of them is involved is Eurotech Wheels, LLC; and that
11 no other business, person or entity with which either of these individuals has any involvement
12 (except Eurotech Wheels LLC, which is a party to the contemporaneous Consent Judgment) has
13 any challenged wheel designs or any wheels for BMWs in its possession, custody or control;

14 d) having represented and warranted that the defendants' total sales of
15 challenged wheel designs and profit thereon are \$20,000 and \$10,000, respectively; and that their
16 total sales of wheel bearing BMW's Roundel or M-stripes logo and profit thereon are \$20,000 and
17 \$10,000, respectively;

18 e) without admitting any liability, and expressly denying same, solely to avoid
19 the expense and distraction of protracted litigation, and wishing to settle their dispute with BMW
20 amicably; and

21 f) California residents residing at 777 6th Ave., San Diego, CA 92101 and
22 6364 El Sicomoro, Rancho Santa Fe, CA 92067, respectively; and having acknowledged the
23 jurisdiction of this Court over them and the subject matter hereof;

24 With the consent of BMW and Ryan and Joshua Moalemi, and for good cause, IT IS
25 DECLARED AND HEREBY ADJUDGED that:

26 This Court has jurisdiction over the subject matter hereof;
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1 BMW has extensively used and advertised its “Roundel” logo, M-Stripes logo and “BMW”
2 word mark in connection with its business of designing, manufacturing, distributing, offering for
3 sale and selling motor vehicles, wheels and other goods and services;

4 BMW is the exclusive owner of valid and subsisting federal trademark registrations,
5 including incontestable trademark registrations for its BMW “Roundel” logo, M-Stripes logo and
6 “BMW” word mark (*see* Exhibit A hereto), and BMW’s Roundel logo and “BMW” word mark are
7 famous; and

8 BMW AG is the owner of various valid and lawfully issued United States Design Patents
9 for designs of vehicle wheels, including but not limited to U.S. Design Patent Nos. 515,491;
10 514,999; 504,382; 493,404; 470,093; 532,358; 558,114; 560,585; 528,962; and 449,028
11 (collectively, the “BMW design patents”) (*see* Exhibit B), and BMW NA is the licensee of said
12 patents in the United States.

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14 With the consent of BMW and Ryan and Joshua Moalemi, and for good cause, IT IS
15 HEREBY ORDERED, ADJUDGED AND DECREED that:

16 1. Ryan and Joshua Moalemi, their agents, servants, employees, representatives,
17 partners, successors, assigns, attorneys-in-fact, and all those persons in active concert or
18 participation with them who receive actual notice of this Consent Permanent Injunction by
19 personal service or otherwise, and each of them, be and hereby are permanently enjoined and
20 restrained from:

21 A. Manufacturing, ordering, accepting orders for, accepting shipment or
22 delivery of, warehousing, manufacturing, importing, advertising or displaying (on the
23 Internet or otherwise), marketing, promoting, offering for sale, selling or otherwise
24 distributing, any wheels depicting, bearing, or in connection with BMW’s Roundel or M
25 Stripes logo (whether standing alone or on a wheel center cap or other tangible item), or
26 any colorable imitations thereof;

27 B. Depicting BMW’s Roundel or M stripes logo, or any other BMW logo, in
28 Eurotech’s advertising, or making any trademark use of the “BMW” word mark, or

1 colorable imitation thereof on or in connection with advertising, offering for sale,
2 displaying, selling, or otherwise distributing wheels, including but not limited to using the
3 phrase “BMW wheels” or the like in connection with its Internet- or other advertising or
4 sales. Metatags, keywords or keyword advertising may not include the phrase “BMW
5 wheels,” “BMW rims,” “M3 wheels,” “M3 rims,” “328 wheels,” “328 rims” or the like,
6 and may not otherwise create a likelihood of confusion as to any connection between
7 BMW and Eurotech, or as to the source, sponsorship, or approval of BMW’s or Eurotech’s
8 goods. They shall cancel Eurotech’s registration of www.eurotechbmw.com and shall
9 cease and desist from registering or using any domain name containing “BMW” or any
10 other BMW Group mark;
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12 C. Any trademark use of any other BMW Group trademark or colorable
13 imitation thereof;

14 D. Doing any other act or thing, directly or indirectly, that is 1) likely to
15 confuse, mislead, or deceive others into believing that Ryan Moalemi, Joshua Moalemi,
16 Eurotech Wheels, Eurotech Rims, or any other person or entity or any of their products or
17 services is connected with, affiliated with, sponsored by, licensed by, or approved by
18 BMW; or that is 2) likely to dilute BMW’s Roundel logo or “BMW” word mark;

19 E. Manufacturing, importing, ordering, accepting orders for, accepting
20 shipment or delivery of, warehousing, advertising, displaying, marketing, promoting,
21 offering for sale, selling, trading, disposing of for commercial gain, or otherwise
22 distributing the wheel models identified in Exhibit C hereto, or any and all other wheels
23 that are covered by the BMW U.S. Design Patent Nos. 515,491; 514,999; 504,382;
24 493,404; 470,093; 532,358; 558,114; 560,585; 528,962; or 449,028.

25 2. Ryan and Joshua Moalemi may make a “fair use” or “nominative use” textual
26 reference, in the identical font, format, size, and color as, and no more prominently than the
27 surrounding text, to “BMW” or to other BMW word marks solely to communicate truthfully that
28 certain Eurotech wheels identified prominently as Eurotech wheels and/or by their third party

1 supplier or manufacturer “fit BMWs” or are “for BMWs,” or fit or are for specific BMW models
2 (such as the M3). No BMW word mark may appear in any of their product or service names.

3 3. Ryan and Joshua Moalemi shall, within thirty (30) days of entry of this Consent
4 Permanent Injunction, notify in writing, with a copy to BMW, any and all third parties with which
5 Ryan or Joshua Moalemi, Eurotech Wheels, Eurotech Rims, or any other person or entity with
6 which either them is involved have placed advertisements using BMW’s Roundel logo, M-Stripes
7 logo or trademark use of the “BMW” word mark, that such usage in advertisements must be
8 removed immediately.

9 4. Ryan and Joshua Moalemi shall, within thirty-five (35) days of entry of this
10 Consent Permanent Injunction, certify personally in a sworn written statement their compliance
11 with and completion of those actions ordered by paragraphs 1 and 3 herein.

12 5. This Court shall retain jurisdiction of this matter and over the parties thereto for the
13 purpose of enforcing the terms of this Consent Permanent Injunction. The parties acknowledge
14 that a breach of this Consent Permanent Injunction by Ryan or Joshua Moalemi would result in
15 immediate and irreparable injury to BMW, and that it would be difficult or impossible to establish
16 the full monetary value of such damage, and that BMW would be entitled to reimbursement of its
17 reasonable attorney’s fees and costs.

18 6. Ryan and Joshua Moalemi shall immediately provide a copy of this Consent
19 Permanent Injunction to any and all of their partners, employees, agents, servants, representatives,
20 successors, and assigns, and any companies in which either of them is involved.

21 7. In the event that Eurotech Wheels fails to timely pay the concurrently agreed-upon
22 \$25,000.00 to BMW, Ryan and Joshua Moalemi shall be jointly and severally liable to BMW for
23 that amount, to be paid immediately to BMW by wire in care of Howrey LLP General Escrow
24 account at Citibank FSB Washington, DC, account number 3700-5235, routing number
25 254070116, identifying on the wire transfer instructions that Eurotech is the party sending the
26 wire.
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1 8. Within ten days of the entry of this Permanent Injunction, Ryan and Joshua
2 Moalemi shall identify, in writing and with specificity, each of their sources, by company name
3 and address, telephone number, principal individual contact, shipper, broker or other purchasing
4 agent, shipping location, and port of entry for each of its wheels accused of design patent
5 infringement. Ryan and Joshua Moalemi shall also provide representative transactional
6 documents sufficient to identify each of their different sources of such wheels.
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8 9. In accordance with § 34 of the Federal Trademark Act, 15 U.S.C. § 1116, the Clerk
9 of the Court shall notify the Commissioner of Patents and Trademarks of the entry of this Consent
10 Permanent Injunction who shall enter it upon the records of the United States Patent and
11 Trademark Office.

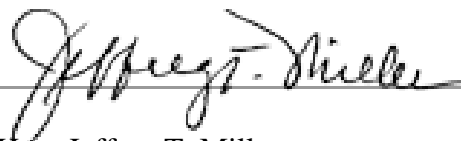
12 10. There being no just reason for delay, the Clerk of this Court is hereby directed to
13 enter this Consent Permanent Injunction forthwith.

14 The parties have consented to the entry of the foregoing Consent Permanent Injunction and
15 waive any and all rights of appeal.

16 The Clerk of Court is instructed to close the file.

17 **IT IS SO ORDERED.**

18 DATED: July 25, 2008

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21 Hon. Jeffrey T. Miller

22 United States District Judge
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